

Remarks/Arguments

Reconsideration is hereby requested, as is a one month extension of time, within which to respond to the non-final Official Action. The Small Entity extension of time fee for one month is in amount of \$55.00 to be charged to Deposit Account No. 502557.

The Examiner has stated that Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts in view of Sundles. Specifically, the Examiner states that "Roberts teaches all of the limitations of these claims except the pressure relief line upstream of the 'normally open' check valve (44)." However, nowhere does Roberts teach the solution advocated in the present application for handling an overpressure condition, as detailed in Figures 3 (schematic view of the pressure-relief circuit of the present system), and 6 (location of the pressure relief valve); and as recited in Claims 1(g) and 3 (the safety circuit) as well as 1(f) (the manual oil change). In addition, The pressure release valve in the present application is external to the pump, rather than internal to the pump, making retrofitting to existing machinery practical. While Sundles teaches "a pressure relief valve (25) in a return line (23) which is located upstream of a check valve (21) from the auxiliary oil pump" it does not teach the method of pump circulation independent of the engine status, nor a manual shut off for oil change as disclosed in the present application Claim 1(f). In contrast to the Examiner's claim that "it would be obvious to modify Roberts by locating a pressure relief valve in the circuit and locating it as taught by Sundles" the applicant asserts that neither Roberts, Sundles nor any other cited references teaches the locating of the pressure relief vale in the circuit, to accomplish the practical retrofitting as discussed; the safety features of handling the over pressure condition; nor the resultant ability to manually change the oil.

Therefore, it would not have been obvious at the time the invention was made, to make such a modification. On issue of obviousness, and in making examination of combination patent with care proportioned to difficulty and improbability of finding invention in assembly of old elements, pertinent question is not whether each element was known or obvious, but whether, considering invention as whole, it would have been obvious to combine elements in claimed relationship; court may look to such evidence of unobviousness as new and advantageous results achieved by claimed invention, industry acceptance, commercial success, and copying by others. *Saturn Mfg., Inc. v. Williams Patent Crusher & Pulverizer Co.*, C.A.8 (Mo. 1983), 713 F.2d 1347, 219 U.S.P.Q. 533. Furthermore, a combination of previously known elements may be nonobvious under certain conditions. *Turzillo v. P & Z Mergentime*, C.A.D.C. 1976, 532 F.2d 1393, 174 U.S.App.D.C. 318, 189 U.S.P.Q. 783, 191 U.S.P.Q. 539, certiorari denied 97 S.Ct. 260, 429 U.S. 897, 50 L.Ed.2d 181, 191 U.S.P.Q. 655.

Where invention sought to be patented resides in combination of old elements, proper inquiry is whether bringing elements together was obvious and not whether one of ordinary skill, having invention before him, would find it obvious through hindsight to construct invention from elements of the prior art. *Application of Warner, Cust. & Pat.App.* 1967, 379 F.2d 1011, 54 C.C.P.A. 1628, 154 U.S.P.Q. 173, certiorari denied 88 S.Ct. 811, 389 U.S. 1057, 19 L.Ed.2d 857, rehearing denied 88 S.Ct. 1201, 390 U.S. 1000, 20 L.Ed.2d 101; *Interconnect Planning Corp. v. Feil*, C.A.Fed. 774 F.2d 1132, 227 U.S.P.Q. 543 (N.Y. 1985); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, C.A.Fed.(Conn.) 1988, 837 F.2d 1044, 5 U.S.P.Q.2d 1434, certiorari denied 109 S.Ct. 75, 488 U.S. 825, 102 L.Ed.2d 51. Combination of prior art features will be deemed obvious only if the prior art references contain a suggestion for so combining their teachings; hindsight afforded by the invention cannot be used to negate its insight. *Becton Dickinson and Co. v. C.R.*

Bard, Inc., 719 F.Supp. 1228, 12 U.S.P.Q.2d 1678, (D.N.J.1989), affirmed 922 F.2d 792, 17 U.S.P.Q.2d 1097. The mere fact that all elements of patentee's composition were formerly used separately to perform same or similar functions, or used in other combinations, will not defeat patent; rather the proper question is whether the new combination would be obvious to one skilled in art, to whom problem was submitted for solution. National Battery Co. v. Richardson Co., C.C.A.6 (Ohio) 1933, 63 F.2d 289.

In cases involving the question of obviousness of combination patents, a court ought to ask first, whether each element of the invention is obvious, second, if so, whether the combination is obvious, and third, if the combination seems obvious in itself, whether the rejection of the contrary teaching in the prior art requires a different conclusion. Burndy Corp. v. Kearney-National, Inc., S.D.N.Y.1979, 466 F.Supp. 80, 201 U.S.P.Q. 801, affirmed 614 F.2d 1286, certiorari denied 101 S.Ct. 82, 449 U.S. 822, 66 L.Ed.2d 25. When determining whether new combination of new elements would have been obvious so as to render patent invalid, analytic focus is upon state of knowledge at time invention was made. In re Raynes, C.A.Fed.1993, 7 F.3d 1037, 28 U.S.P.Q.2d 1630. Before Patent and Trademark Office may combine disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in references themselves or in knowledge generally available to one of ordinary skill in art. In re Jones, C.A.Fed.1992, 958 F.2d 347, 21 U.S.P.Q.2d 1941.

The Examiner has also stated that claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts and Sundles as applied to claim 2 above, and further in view of Biess. In lieu of the applicants arguments, *supra*, the applicant submits that claim 4 is not unpatentable as applied to claim 2 above. Biess teaches protection of an

electrically driven oil pump from overloads using circuit breakers. However, said overloads relate to electrical overloads, rather than the over-pressure condition as described in the present application. Furthermore, the applicant has submitted herewith, a declaration under 37 CFR 1.131 attesting to a date of conception in 2000 and reduction to practice in 2001. Biess was filed in 2002; however, as is stated in the attached declaration, the applicant's invention was reduced to practice prior to the effective date of Beiss.

In view of the foregoing, it is respectfully submitted that the obviousness-type patenting rejection of Claims 1-5 has been overcome and it is therefore requested that it be withdrawn. New Claim 6 depends on Claim 4, but incorporates the limitations of Claim 3. It thus depends from an originally allowed claim.

For the foregoing reasons, it is respectfully submitted that the Claims 1-6 are in condition for allowance.

3.7-05
Date of Signature

Respectfully submitted,
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